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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/865,474	05/29/01	MOGIL	100570-00019

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EXAMINER
LUONG, S

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 10/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/865,474

Applicant(s)

MOGIL, MELVIN S.

Examiner

Shian T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-42, 45-77 is/are rejected.
- 7) ☒ Claim(s) 43 and 44 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/122,088
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 58-76 been renumbered 59-77

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-2 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-4 of U.S. Patent No. 6,092,661 in view of Hollingsworth. Although the conflicting claims are not identical, they are not patentably distinct from each other because Hollingsworth teach the obvious element of a pocket within an auxiliary compartment.

4. Claims 4-37, 46, 56-57, 62-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,237,776 in view of Hollingsworth (US 5,217,119). Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same structural feature in claim 4 of the instant application and excludes the exact shape of the container in claim 4.

Claim Rejections - 35 USC § 112

5. Claims 51-55 and 66-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 51 is inaccurate because the sidewall is not cylindrical entirely. The back portion of the sidewall is flat. Claims 66-68 are inaccurate and indefinite. The quick release hook element and the strap are not attached to the leading portion of the

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sidewall. They are secured to a ring portion extending from a loop portion of the sidewall.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 36, 45, 47, 49, 51-52, 55, 56, 60, 62, 63, 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Workman (US 4,537,313) in view of Official Notice. Workman discloses an insulated container comprising an insulated compartment. A lid 16 covers the compartment and an external strap 20 attached to the side walls. Workman discloses all of the elements of the claims, but does not show the D-shape as recited in claims 36 and 56, the web bands as recited in claim 45, the girth reinforcements as recited in claims 62-64. However, Official Notice is taken of conventional design to provide a container in any of variety of desire shapes. Reinforcements around the container are also well known to strengthen the structure thereof. It would have been obvious in view of Official Notice to provide the desire shape and reinforcements for the container of Workman to attract buyer and strengthens the container.

8. Claims 37-42, 58, 72-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claims 36 and 56, further in view of Lehmann et al

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(Des.387,198). Workman discloses all of the limitation of the claims, but lacks an auxiliary compartment. However, Lehmann et al suggest providing a secondary wall structure with a top portion and a lower portion. The top portion has a flap that is secured to the sidewall of the secondary wall structure by a zipper. The lower portion also has a pocket formed therein and is closed by a zipper as well. Hence, it would have been obvious in view of Lehmann et al to provide compartment on the external portion of Workman to carry additional items therein.

9. Claims 48 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claims 47 and 56, further in view of Pasco et al (US 3,915,304). Workman does not provide a lid with inner reflective surface as recited in claims 48 and 61. However, Pasco et al teach a reflective surface 26 in an interior surface of the lid. Therefore, it would have been obvious in view of Pasco et al to provide a reflective surface within the container of Workman to better insulate the container with the aluminum foil.

10. Claims 51-53, 55 and 64-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 36 and 56, further in view of Lippincott et al (Des. 371,942). Workman does not show the releasable hooks as recited in claim 51 and 64. Lippincott et al teach an alternative carrying strap with a hook portion secured to a loop portion of the container. The hook portion is removable from the loop portion. Hence, it would have been obvious in view of Lippincott et al to provide the removable hook portion for the securement device of Workman to allow the user to remove the strap when is deemed unnecessary.

11. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 36, further in view of Fox (US 5,884,768). Workman

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discloses all of the elements of the claims, but does not show a handle on the lid portion as recited in claim 50. However, Fox shows a handle 17 on a lid portion of the container. Hence, it would have been obvious in view of Fox to provide a handle on the lid portion of Workman to facilitate handling of the container.

12. Claims 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 52, further in view of Von Neumann (US 5,934,527).

Workman discloses all of the elements of the claims, but lacks a second mount. However, Von Neumann suggests providing shoulder straps 26 connectable by releasable hooks 28 onto loops 30. One loop is attached to the top of the bag and two other loops are attached to the back of the bag at a bottom of bag. Two straps 90 are connected to a side of a middle portion 14 which strap portions can be used to encircle the waist of a user. Therefore, it would have been obvious in view of Von Neumann to provide a second form of mounting on the bag of Workman to secure the bag onto a waist of a user.

13. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 56, further in view of Jacober (US 4,767,039). Workman discloses all of the elements of the claims, except for a pocket mounted on the side portion. However, Jacober suggests a backpack comprising an insulated compartment 23 in various forms as shown in Figures 1 and 5-9. The backpack has a carrying strap on a rear portion thereof and compartments 88 and 89 on the side portion of the backpack. Therefore, it would have been obvious in view of Jacober to provide additional compartments on the side of the bag of Workman to carry additional contents.

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14. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 69, further in view of Pelavin (US 4,378,866). Workman discloses all of the elements of the claims, but does not show a slanted compartment on a side portion of the container. However, Pelavin suggests providing a slanted pocket on a side portion of the container to store equipment therein. Therefore, it would have been obvious in view of Pelavin to provide pocket opening in a slanted shaped for the container of Workman to facilitate retrieval of the article from the pocket.

15. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 56, further in view of Fox (US 5,884,768). Workman discloses all of the elements of the claims, but does not show a handle on the lid portion as recited in claim 50. However, Fox shows a handle 17 on a lid portion of the container. Hence, it would have been obvious in view of Fox to provide a handle on the lid of Workman.

16. Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 69, further in view of Bearman (US 5,288,150). Workman as modified above discloses all of the elements of the claims, but does not show a see-through compartment on a container. However, Bearman also suggest providing see through pockets on a tote-bag. Therefore, it would have been obvious in view of Bearman to provide see through pockets for the container of Workman to allow visual inspection of the article therein.

17. Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 73, further in view of Bearman (US 5,288,150). Workman discloses all of the elements of the claims, but does not show a see-through mesh pocket mounted externally to the auxiliary compartment. However, Bearman also suggests providing

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see through mesh pockets on a tote-bag. Hence, it would have been obvious in view of Bearman to provide a see-through mesh external pocket to the exterior portion of the auxiliary compartment of Workman to provide additional storage area and to allow visual inspection of the content.

Allowable Subject Matter

18. Claims 43, 44, 46 and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19. Claims 1-35 would be allowable once a terminal disclaimer is submitted and approved.

Conclusion

20. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

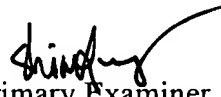
If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Valerie Douglas at (703)308-1337.

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For applicant's convenience, the Group Technological Center FAX number is (703) 305-3579 or (703)305-3580. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (703) 308-2039. The examiner can normally be reached on M-TH 7:00 am until 4:00 pm (EST).

STL
October 26, 2001


Primary Examiner
Shian Luong
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